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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,715	05/24/2000	CHRISTOPHER BEVAN	REF/BEVAN/711	2485

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[REDACTED] EXAMINER

GAKH, YELENA G

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 03/31/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/486,715	BEVAN ET AL.
	Examiner Yelena G. Gakh, Ph.D.	Art Unit 1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Peri d f r Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 February 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disp sition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) 1-5, 13 and 14 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 6-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 24 May 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

1. The Response to Restriction Requirements with election of Group II (claims 6-12) with traverse, filed on 02/05/03, is acknowledged. Claims 1-14 are pending in the Application. Claims 1-5 and 13-14 are withdrawn from consideration. Claims 6-12 are examined on merits.

In response to the Applicants' arguments related to the operation of the claimed apparatus the examiner would like to notice, that this argument is not relevant to the subject matter of the elected claims drawn to the apparatus, as the operation and the structure of the apparatus are different issues; two devices of different structures can perform similar operations, and *vice versa*. Increasing the amount of one compound while decreasing the amount of another is related to the method of employing the apparatus, rather than its structure. Moreover, none of the claims of the elected group recites this feature, since this is not a structural feature of the apparatus. As it was indicated in the previous Office action, all the structural features of the apparatus of the instant Application are anticipated or obvious over the prior art, which makes the restriction requirements proper and FINAL.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites "a plurality of samples", while the parent claim recites "the fluid". It's not clear, if "a plurality of samples" means "a plurality of fluids", or these are different samples of the same fluid?

Claim 12 provides for the use of an analytical device, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is

intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 6-10** are rejected under 35 U.S.C. 102(b) as being anticipated by Surjaatmadja (US 5,192,509).

Surjaatmadja discloses an apparatus for automatic titration, comprising: at least two input ports in fluid communication with a common channel, a detection zone having an input in fluid communication with the common channel and the output, a color detector for detecting the color of the fluid (e.g. any spectrophotometer, including ultraviolet, visible range spectrophotometer, etc. as indicated in col. 1), and control means connected to continuous flow type metering pumps to vary the composition of the fluid continuously and linearly (Figure and col. 2, lines 50-60). The control means are “preferably syringe-type pump that operate under control of a stepping motor” (col. 2, lines 58-62). “The automatic titration system 10 is capable of operation in a selected one of two modes, a batch processing mode and a continuous mode. The batch processing mode enables the sampling of a multiple of fluids which may then be subject to reaction to identify the types of fluids”.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Surjaatmadja in view of Garrison et al. (US 4,810,331).

Surjaatmadja does not specifically disclose autosampler in his apparatus.

Garrison discloses “surfactant sensing electrode for potentiometric titrations” and indicates, “it should be appreciated that potentiometric quantitation of surfactant samples using a coated-wire membrane electrode as described above can be automated by employing an autosampler in conjunction with a potentiometric titration instrument. In some cases, such potentiometric titrations may take as little as two minutes per sample, compared with thirty

minutes per sample when using manual two-phase titration methods or chromatographic procedures" (col. 16, lines 30-39).

It would have been obvious for anyone of ordinary skills in the art to use autosampler in Surjaatmadja's apparatus, as disclosed by Garrison, because Garrison specifically indicates advantages of automating the operation of the disclosed analytical device by employing such autosampler.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (703) 306-5906. The examiner can normally be reached on 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Yelena Gakh  
March 24, 2003

